

European Patent Office: The Enlarged Board of Appeal in the “Pepper” case (G3/19)

On 14 May 2020, the European Patent Office (EPO) Enlarged Board of Appeal has decided that plants, or animals, obtained via an “essentially biological process” are not patentable.

This is the outcome of the interpretation of the scope of art. 53(b) of the European Patent Convention (EPC), which notably forbids the patentability of "*plant or animal varieties or essentially biological processes for the production of plants or animals*", in the light of Rule 28(2) of the EPC Implementing Regulations, which reads: "*European patents shall not be granted in respect of plants or animals exclusively obtained by means of an essentially biological process*".

The President of the EPO referred to the Enlarged Board of Appeal, the EPC's system highest instance, seeking its opinion on the application of Rule 28(2), after that, in case T1063/18, the Board of Appeal decided not to apply that Rule, considered in conflict with Art. 53(b) EPC, as interpreted in previous Enlarged Board decisions, G2/12 and G2/13 (“Tomatoes II” and “Broccoli II”). Thus, according to the decision of the Board, plants produced by essentially biological processes would be patentable.

The case concerns the application for a patent covering a blocky fruit type pepper plant of dark green colour (hence the headword “Pepper”), rejected by the EPO Examining Division, on ground that the claims were contrary to Rule 28(2) EPC, because they relate to a plant produced by an essentially biological process. Case T1063/18 is the appeal filed by the patent applicant, ended with the Board overturning the Examining Division's conclusions, as seen above.

The differing case-law (in respect with Rule 28(2)) mentioned by the Board in T1063/18 is represented by cases G2/12 and G2/13, Enlarged Board decisions stating, fundamentally, that even if claims relating to an essentially biological process for producing plants are not allowable pursuant to art. 53 (b) EPC, this does not preclude patentability of claims to a plant product produced by an essentially biological process.

Under Article 164(1) EPC, the Implementing Regulations are an integral part of the Convention, therefore, they are binding to the EPO Boards of Appeal (Art. 23(3) EPC) and to national courts. Rule 28 was amended in 2017 by the EPO Administrative Council, with the introduction of paragraph (2). This amendment, in force since 1 July 2017, aims to put the EPC system in line with Directive EC 98/44 on the legal protection of biotechnological inventions (the Biotech Directive), and namely with the content of the European Commission’s notice of 3 November 2016, concerning the interpretation of certain aspects of the Biotech Directive, which concludes that the “*Commission takes the view that the EU legislator's intention when adopting Directive 98/44/EC was to exclude from patentability products (plants/animals and plant/animal parts) that are obtained by means of essentially biological processes.*”. Even though the Commission’s document was not binding on the EPO, its Administrative Council decided to amend Rule 28 accordingly.

As a result, previous case-law became incompatible with the new authentic interpretation of plants or animals exclusively obtained by means of an essentially biological process.

In G3/19, the Enlarged Board of Appeal adopted a “dynamic interpretation” of the EPC, thus abandoning its earlier interpretation of Article 53(b) EPC in decisions G 2/12 and G 2/13. On this, the Enlarged Board explained that “*a particular interpretation which has been given to a legal provision can never be taken as carved in stone, because the meaning of the provision may change or evolve over time*”. In other words, the fact that the introduction of Rule 28(2) contradicts settled Enlarged Board’s case-law - i.e. “Tomatoes II” and Broccoli II” – does not mean that that provision should not be applied. To the contrary, the interpretation of the EPC must evolve in line with the new interpretative rule introduced by the Administrative Council in 2017.

The Enlarged Board thus held that, after the introduction of Rule 28(2) EPC, Article 53(b) EPC is to be interpreted to exclude from patentability, accordingly, plants, plant material or animals, if the claimed product is exclusively obtained by means of an essentially biological process or if the claimed process features define an essentially biological process.

For the sake of legal certainty, the Enlarged Board specified that the new interpretation of Article 53(b) EPC given in G 3/19 has no retroactive effect on European patents containing such claims, which were granted before 1 July 2017 (the date of entry into force of Rule 28(2)), nor on pending European patent applications seeking protection for such claims filed before that date.